REMARKS

The paragraph at page 4, lines 1-6 has been amended by replacement with a paragraph that deletes the word "preferred" that was added thereto by a previous amendment. This moots the Examiner's objection to the specification under 35 U.S.C. 132 for introducing new matter and also the rejection of 1-16 and 24 under 35 U.S.C. 112, first paragraph for new matter. The paragraph at page 3, lines 9-13 has been amended by replacement with a paragraph that deletes the word "aliphatic", this is a correction of an obvious mistake. As the paragraph at page 4, lines 1-6 states: "A large percentage of the formulation comprises alkyl benzenes." The example of the invention at pages 12-13 illustrates the formulation of the invention to have a large percentage of alkyl benzenes. The invention formulation is greater than 95 percent hydrocarbons but the mistake resided in identifying the hydrocarbons to be "aliphatic" which alkyl benzenes are not.

In the parent application to this submission the Examiner rejected claims 1-18 and 24 under 35 U.S.C. 103(a) as being unpatentable over Nair et al (Nair) 5,786,134 in view of Nicholas et al (Nicholas) 5,462,459, Stowell 5,443,604, Booser's Handbook of Lubrication and Schey's Tribology in Metal-Woorking; "Function Lubrication and Wear" for reasons made of record in Paper No. 3 dated January 30, 2003. Applicant respectfully traverse this rejection and request reconsideration in view of the remarks which follow.

Nair teaches the manufacture of a motion picture print film having a support, an antihalation undercoat, a silver halide emulsion, an antistatic and protective overcoat layers. Nair further discloses that paraffins may be used as a lubricating agent "to give the topcoat a coefficient of friction that ensures good transport characteristics *during manufacturing and customer handling of the photographic film.*" [Emphasis added.] *See* Nair, col. 8, lines 45-51. Notably, Nair teaches that the lubricating agent is preferably an aqueous dispersed lubricant that can be incorporated directly into the solid protective topcoat layer so as to avoid a "separately applied lubricant overcoat on the protective topcoat layer." *See* Nair, col. 8, lines 66-67 and col. 9, lines 1-3. Thus, the lubricating agent is only a component of the solid laminated topcoat layer, but is not in contact with the film.

The Examiner states that "[i]t would be obvious to the artisan in the art to select a mixture of aliphatic hydrocarbons of the secondary references as the paraffin lubricant and carriers preservative formulation for the topcoat composition of Nair for print film preservation because the solvent mixture is a conventional combination for preservative formulation." For the reasons noted here after, Applicant traverses the Examiner's rejection under 35 U.S.C. 103(a) based on the assertion that one skilled in the art of the preservation of a film would look to the wood preservation compositions taught by Nicholas and the plastic surface polishing compound teachings of Stowell in light of the state of the art disclosed in Boozer and Schey to render the claimed formulations and method for the preservation of film as claimed by Applicant obvious.

A paraffin is a saturated aliphatic hydrocarbon (see Hackh's Chemical Dictionary 4th edition 1969, "paraffins. (1) Alkanes. (2) CnH2n+2 . Saturated aliphatic hydrocarbons of the methane series." page 488). Nair teaches that "paraffins" and/or a "paraffin wax" may be included as an ingredient in a topcoat over a polyurethane overcoat of a film. One of ordinary skill in the art would understand the "paraffins" and/or "paraffin wax" used by Nair as a lubricating agent to be a substance as described by Schey at page 136 at section 4.2.4; namely, a substance consisting chiefly of straight-chain C_{18}-C_{40} paraffins with melting points ranging from 27 to 80° C. Nothing in Nair suggest that the paraffins and/or paraffin wax component should or could be substituted for by the "solvent/dilutant" used in the wood preservative composition of Nicholas. Nicholas describes the solvent/dilutant to be water or a liquid hydrocarbon. Nicholas describes suitable hydrocarbon liquids to include aromatic and aliphatic hydrocarbon solvents such as petroleum hydrocarbon solvents, aromatic hydrocarbons, aromatized petroleum distillates, and mixtures of petroleum hydrocarbon solvents and aromatic hydrocarbon solvents. Nicholas describes examples of useful solvents to include xylene, toluene, naphtha, light mineral oil, etc Such a "solvent/dilutant" is not a paraffin, it is a liquid and in addition to aliphatic hydrocarbons it contains aromatic hydrocarbons. Nair simply does not describe or suggest the use mixed aromatic and aliphatic hydrocarbon solvents as a lubricant and the paraffins and/or paraffin wax lubricant of Nair does not describe or suggest the use mixed aromatic and aliphatic hydrocarbon solvents of Nicholas as a lubricant in the film of Nair. All rejections based on the combination of Nair with Nicholas should be withdrawn

Nothing in Nair suggest that the paraffin component (chiefly of straight-chain C_{18}-C_{40} paraffins with melting points ranging from 27 to 80° C) should or could be substituted for by the plastic surface polishing compound of Stowell, such polishing compound with its abrasive particles (2.5-15 parts), petroleum distillate lubricant (4-17 parts), mineral spirits (1-6 parts) and water (2.5-10 parts)simply is not a "paraffin." It is a liquid composition and its lubricate component, comprised of heavy naphthenic distillates and heavy aliphatic solvents, is not paraffins and/or a paraffin wax. Nair simply does not describe or suggest the use heavy naphthenic distillates and heavy aliphatic solvents as a lubricant and the paraffins and/or paraffin wax lubricant of Nair does not describe or suggest the heavy naphthenic distillates and heavy aliphatic solvents of Stowell as a lubricant in the film of Nair. All rejections based on the combination of Nair with Stowell should be withdrawn

Nothing in Nair suggest that the paraffin component (chiefly of straight-chain C_{18}-C_{40} paraffins with melting points ranging from 27 to 80° C) should or could be substituted for by the petroleum-based "mineral" oils of Booser which in addition to its paraffinic hydrocarbon content also contains naphthenic (cyclic paraffin) and aromatic hydrocarbons which are not parafins. Nair simply does not describe or suggest the use of petroleum-based "mineral" oils of Booser as a lubricant and the paraffins and/or paraffin wax lubricant of Nair does not describe or suggest the petroleum-based "mineral" oils of Booser as a lubricant in the film of Nair. All rejections based on the combination of Nair with Booser should be withdrawn

Nothing in Nair suggest that the paraffin component should or could be substituted for by the paraffinic /naphthenic oils of Schey. If one of ordinary skill in the art were to draw any conclusion from the combination of Nair with Schey that conclusion would be to use the substance as described by Schey at page 136 at section 4.2.4 (Mineral Waxs); namely, a substance consisting chiefly of straight-chain C_{18}-C_{40} paraffins with melting points ranging from 27 to 80° C as the lubricating agent in the film of Nair. However such a substance is not a aliphatic petroleum naphtha, aliphatic petroleum distillate, nor a petroleum base oil as required by these claims. All rejections based on the combination of Nair with Schey should be withdrawn

That the solvent mixture of the secondary references may contain as an ingredient thereof a paraffin does not mean that the solvent mixture is a paraffin. Nair does not describe or suggest as a lubricating agent the use of solvent mixtures as described by any of the secondary references. Accordingly no combination of Nair with a secondary reference suggest a mixture comprised of (a) aliphatic petroleum naphtha; (b) aliphatic petroleum distillates; and (c) petroleum base oil as a formulation for the preservation of a film.

For the reasons that claims 1-18 and 24 are allowable so to are claims 19-23 which were withdrawn from consideration. Applicant respectfully request that claims 19-23 be returned to consideration and allowed.

CONCLUSION

It is respectfully submitted that all issues and rejections have been adequately addressed and that all claims as amended and pending following entry of this Amendment are now allowable and that the case should be advanced to issuance.

If the Examiner has any questions or wishes to discuss the claims as amended, the Examiner is encouraged to call the undersigned at the telephone number indicated below.

Respectfully submitted,

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